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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,536	06/14/2001	Jack D. Patterson	65856-0032 (00-TRN-379)	8152
10291	7590	03/01/2005	EXAMINER LEE, JINHEE J	
RADER, FISHMAN & GRAUER PLLC 39533 WOODWARD AVENUE SUITE 140 BLOOMFIELD HILLS, MI 48304-0610			ART UNIT 2831	PAPER NUMBER

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/881,536
Filing Date: June 14, 2001
Appellant(s): PATTERSON, JACK D.

MAILED
MAR 1 2005
GROUP 2800

Michael B. Stewart
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 13, 2004.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

Appellant's brief presents arguments relating to new matter mentioned in a subsequent paper (i.e. advisory action). This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-12 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,257,923	Stone et al.	7-2001
4,929,477	Will	9-1990

Appellant's specification and prior art figure 2

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-12 are rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on November 15, 2002.

(11) Response to Argument

A. In response to applicant's arguments that Claims 1 and 7 recite a novel structure and therefore all claim groups are allowed, examiner disagrees.

In the advisory action, the use of the phrase New Matter regarding the argument that brought out new issues was inadvertent. 112 new matter rejection was not made in the advisory nor in any office action.

In claims 1 and 7, the applicant describes portions "spliced into" other portions. Examiner maintains that splicing is a method limitation. MPEP 2113 quotes "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

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unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

In regards to the argument regarding the commercial advantages in support of the novelty, again, the examiner recites "It would have been obvious to one having ordinary skill in the art at the time the invention was made to pre-assemble the data link assembly, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893)."

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B. In response to applicant's arguments that Claim Group B is in condition for allowance because the examiner has improperly taken official notice, examiner disagrees.

The applicant did not contest the official notice prior to the final rejection.

In regards to the official notice "that it would have been obvious to use multiplex cable in the trunk portion of the vehicle drivetrain, because the trunk portion of the vehicle drivetrain in an automated vehicles' controller requires ability to send and/or receive multiple signals", examiner presents prior art document titled Radox "Plug and Play" Cable. The applicant has admitted that multiplex cables are known (see specification page 6 paragraph [0025]). The currently presented prior art document dated 1998 states that the cable can be used with a drivetrain of a vehicle (see page 1 first paragraph). Radox is presented merely in support of the Examiner's statement of Official Notice. In no way should the presentation of Radox be construed as a new or different grounds of rejection.

C. In response to applicant's arguments that Claim Group C is in condition for allowance because the examiner has wrongly asserted that housing first and second termination resistors in a Barrel Mold is a Design Choice, examiner disagrees.

The applicant did not contest this rejection prior to the final rejection.

In regards to the rejection "It would have been an obvious matter of design choice to use said first and second termination resistors housed in a barrel mold, since applicant has not disclosed that having said first and second termination resistors housed in a barrel mold solves any stated problem or is for any particular purpose and it

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appears that the invention would perform equally well with any conventional termination resistors as is disclosed in Applicant's prior art figure 2", examiner presents prior art Burns (US005882215A). The applicant discloses a pair of termination resistors (68) in admitted prior art figure 2. The admitted prior art figure 2 does not disclose the resistors housed in a barrel mold. Burns teaches that barrel connector is only an example of a connector that can be used as a cable connector ("standard cable connector or jack such as an "F" type barrel connector", see column 8 lines 8-10 according to the numbering in the middle). Therefore, examiner maintains that use of barrel mold is an obvious design choice. The paragraphs presented from the specification do not disclose that use of a barrel mold renders the cited advantages. The advantages cited by the applicant in the appeal brief in defense of use of a barrel mold is actually used in the specification to describe advantages of having a pre-assembled device. Furthermore, the use of a standard connector, which is not of the barrel mold type, would not take away from the novelty of the applicant's invention.

D. In response to applicant's arguments that Claim Group D is in condition for allowance because the examiner Failed to State a Prima Facie Case of Obviousness for Combining the Cited References, examiner disagrees.

The applicant did not contest this rejection prior to the final rejection.

Applicant argues that "the Final Office action points to no motivation to combine Stone and Will with each other." Examiner had stated that "...It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the double wall shrink tube as taught by Stone et al. and Will on the assembly as

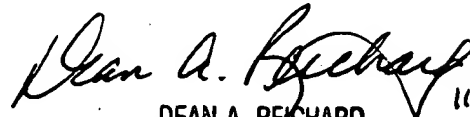
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disclosed in Applicant's specification and Applicant's prior art figure 2 in order to **interconnect different parts.**" The motivation statement has been bolded.

For the above reasons, it is believed that the rejections should be sustained.

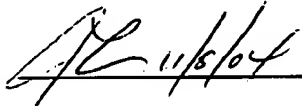
Respectfully submitted,

jji
November 1, 2004

 11/5/04
DEAN A. REICHARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

Conferees

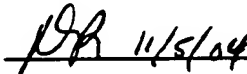
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